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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/316,795 05/21/99 SANSONE

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EXAMINER

SOUGH, H

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/316,795

Applicant(s)

SANSONE ET AL.

Examiner

Hyung S. Sough

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 13 August 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 13, 20001 have been approved by the Examiner.

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al. (Boies hereinafter: US PAT. 6,006,200) in view of Allum et al. (Allum hereinafter: US PAT. 5,420,403).

Boies discloses a method of forwarding mail (i.e., a package delivered by U.S. Postal Service) that is addressed to a recipient (i.e., "a customer") and a virtual post office box (i.e., "a unique identifier to the customer") to be delivered directly to a recipient, said method comprises the steps of:

receiving recipient's name and information regarding recipient's desired delivery address (this step would have been inherent to create the database owned by the shipping company and to generate the unique identifier to the customer);

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assigning a virtual post office box for individual recipients (see column 2, line 12, “to supply a unique identifier to the customer”);

relating recipient’s virtual post office box with recipient s desired delivery address (this step would have been inherent to be able to deliver the mail to the correct customer);

delivering to recipient's their assigned virtual post office boxe’s identification (see column 2, line 12, “to supply a unique identifier to the customer”);

placing virtual post office boxes on the mail (see column 2, lines 55-60);

reading mail to capture virtual post office box identification, when present (see column 2, lines 60-64);

determining recipient's desired delivery address from virtual post office box information and recipient's name (see column 2, lines 18-22 and 60-64);

verifying in one or more data bases that recipient’s name is listed with recipient’s desired delivery address (see claim 1, i.e., “accessing the master file database by a shipper to obtain the customer’s shipping address.”); and

delivering the mail to the desired delivery address of the recipients (see column 2, lines 60-64).

Re claim 1: Boies does not explicitly disclose the steps of placing recipient’s desired delivery address on mail in coded form and human readable form. However, Allum discloses the use of coded form, human readable form or both to print a delivery label (see FIGS. 7 and

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8) to facilitate the routing of the mail automatically and to assist a delivery person to find correct delivery addresses. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Boies by adopting the teachings of Allum to facilitate the routing of the package automatically and to assist a delivery person to find correct delivery addresses.

Re claim 6: Boies further discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions (see claim 5).

Re claim 7: Boies does not explicitly disclose the changing step that further includes recipient specifies the time period in which mail is going to be delivered to the desired delivery address. However, it is old and well-known practice to specify the time period in which mail is going to be delivered to the changed delivery address (e.g., when someone is on vacation, it has been a common practice to notify the Post Office to reroute the mail to a next neighbor or hold until the person comes back from the vacation), and nothing unobvious is seen to have been involved simply having employed this old and well-known practice for the claimed method to facilitate the mail delivery.

Re claims 8, 9 and 10: Boies does not explicitly disclose the step of billing for the number of times (or metering) recipient's changed their desired delivery address. However, it is a fundamental practice to charge any viable services including the claimed service in the art to obtain higher profit. Thus, it would have been within the level of ordinary skill in the art to employ this fundamental practice to the claimed method to increase the profit.

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Re claim 11: Boies further discloses that the recipient's virtual post office box is represented in alphanumeric characters (see column 2, lines 14-16).

Re claims 12 and 13: Boies does not explicitly disclose the steps of (a) assigning access codes to recipients that are related to recipient's virtual post office box; (b) delivering access codes to recipients; (c) receiving recipient's name, access code and recipient's intention to change their delivery address; and (d) changing recipient's delivery address upon conformation of recipient's name and access code. However, in claim 5 thereof, Boies discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions (see claim 5). Of course, **to keep anonymity and privacy** (see the Abstract of Boies), the use of the claimed steps for changing the delivery address would have been within the level of ordinary skill in the art. More specifically, it would have been obvious to (a) assign access codes (e.g., passwords) to recipients that are related to each recipient's virtual post office box to prevent others from accessing unauthorized post office boxes; (b) deliver access codes to recipients to allow each recipient to access his or her post office box for the desired address change; (c) receive recipient's name, access code and recipient's intention to change their delivery address to update the change of the address; and (d) change recipient's delivery address upon conformation of recipient's name and access code to effect the change of the address.

Re claim 14: Boies does not explicitly disclose the changing step that further includes recipient specifies the time period in which mail is going to be delivered to the changed

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delivery address. However, it is old and well-known practice to specify the time period in which mail is going to be delivered to the changed delivery address (e.g., when someone is on vacation, it has been a common practice to notify the Post Office to reroute the mail to a next neighbor or hold until the person comes back from the vacation), and nothing unobvious is seen to have been involved simply having employed this old and well-known practice for the claimed method to facilitate the mail delivery.

Re claim 15: Boies does not explicitly disclose the steps of (a) assigning a biometrics to recipients; (b) delivering the biometrics to recipients; (c) receiving recipient's biometrics and recipient's intention to change their delivery address; (d) changing recipient's delivery address upon conformation of recipient's biometrics. However, in claim 5 thereof, Boies discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions (see claim 5). Of course, **to keep anonymity and privacy** (see the Abstract of Boies), the use of the claimed steps for changing the delivery address would have been within the level of ordinary skill in the art. More specifically, it would have been obvious to (a) assign a biometrics (e.g., finger print) to recipients that are related to each recipient's virtual post office box to prevent others from accessing unauthorized post office boxes; (b) deliver the biometrics to recipients to allow each recipient to access his /her post office box for the desired address change; (c) receive recipient's biometrics and recipient's intention to change their delivery address to update the change of the address; and (d) change recipient's delivery address upon conformation of recipient's biometrics to effect the change of the address.

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Re claims 16, 17, 18, 19 and 20: Boies does not explicitly disclose that the recipient's name, access code and recipient's intention to change their delivery address may be received by telephone, by facsimile, by computer, in person, or by mail. However, those are well-known methods of notifying the changes of personal information, and it would have been common sense to employ any one of the above well-known methods as desired to notify the changes of the personal information (e.g., address, phone number, or etc.) to effect the change of the address.

Re claim 21: Boies does not explicitly disclose that the recipient's access code is encrypted. However, it is a well-known practice in the art to encrypt any vital information in the art to prevent fraudulent access of the personal account or database and it would have been common sense to employ this well-known practice for the claimed method to further enhance the **anonymity and privacy** (see the Abstract of Boies) of the recipient.

4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boies in view of Allum as applied to claim 1 above, and further in view of Allen et al. (Allen hereinafter: US PAT. 5,422,821).

Boies does not explicitly disclose that one of the data bases is the National Name and Address Data Base. However, Allen teaches the use of the National Name and Address Data Base (i.e., US PS National Change of Address database) to identify, intercept and forward incorrectly addressed mailpieces. Thus, it would have been within the level of ordinary skill in the art to

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further modify the method of Boies modified by Allum by adopting the teaching of Allen to identify, intercept and forward incorrectly addressed mailpieces.

Response to Arguments

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show a certain feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., "Post's verifying in one ore more data bases that recipient's name is listed with recipient's desired delivery address on mail in coded form and human readable form.") is not recited in the rejected claim(s). More specifically, the claims as amended recite "verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address;" but does not recite "Post's verifying in one ore more data bases that recipient's name is listed **with recipient's desired delivery address on mail in coded form and human readable form.**" (Emphasis added) Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

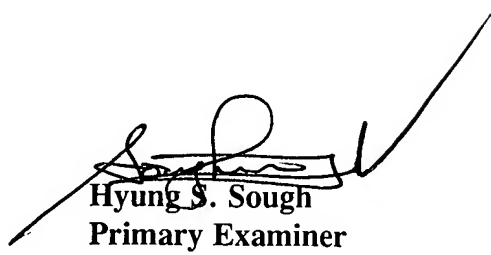
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax numbers are (703) 746-7238 for After-final, (703) 746-7239 for Official, and (703) 746-7240 for Non-Official/Draft



Hyung S. Sough
Primary Examiner
Art Unit 2161

shs
October 16, 2001